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REMARKS

Status of Claims

After entry of the above amendments, claims 1-27 are pending. Claims 10, 14-16, and 21 are amended. Claims 22-27 are added, without adding new matter, to claim the invention more extensively.

Item 1 of the Office Action acknowledges Applicants' previous amendment.

Item 2 points to code sections.

Item 3 rejects claims 10, 12-15 under 35 U.S.C. 102(e) as being anticipated by Milewski et al. (U.S. Pat. No. 6,519,326, hereinafter "Milewski").

Item 4 points to code sections.

Item 5 rejects claims 1-9, 20 and 21 under 35 U.S.C. 103(a) as being unpatentable over Adams (U.S. Pat. No. 6,400,814) in view of Wolff et al. (U.S. Pat. No. 5,327,486, hereinafter "Wolff").

Item 6 rejects claims 11 under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Wolff.

Item 7 rejects claims 16-19 under 35 U.S.C. 103(a) as being unpatentable over Weishut et al. (U.S. Pat. No. 6,047,057, hereinafter Weishut) in view of Wolff.

Item 8 states that Applicants' previous arguments have been considered but are moot in view of the new ground(s) of rejection.

Items 9-11 state that the Office Action is final and give contact information.

For efficiency in advancing prosecution, rejections may be discussed below as though applied even to claims that are amended.

Claims 10, 12-15

Claims 10, 12-15 stand rejected under 35 U.S.C. 102(e) as being anticipated by Milewski.

Milewski teaches a system by which an incoming telephone call is announced by the called party's equipment not by a mere ring-tone but by a voice announcement such as "Hi, Allen, this is Bob...". (Milewski, col. 3, line 51,

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which is within a section cited in the Office Action.) Milewski also provides a feature by which, "if the called party desires to accept the incoming phone call after receipt of the voice-ring announcement, the called party will transmit a return signal, or call answer message, from the called party's PC 155 to the calling party's PC 105 ... to signal that the call is to be accepted..." (Milewski, col. 4, lines 28-34).

Claim 10, as amended, recites a feature of "a controller for activating the command interface in response to the detection signal and for transferring, even in an instance in which the called party intends not to answer the incoming call, the customized message to the caller, the customized message having been customized according to the message parameters, wherein the controller is an element of a telephone" (underlining added). One embodiment of this feature is illustrated by an example customized message that states that "the user will call back in ten minutes". (Application, page 6, line 13).

Milewski simply does not teach such a feature. On the contrary, as was shown above, Milewski specifically teaches away from such a feature by teaching that its call answer message is specifically to signal that the call is to be "accepted", which is the opposite of some of the above-underlined language from claim 10. Accordingly, Applicants respectfully submit that claim 10 is not anticipated by Milewski.

Applicants further respectfully submit that there is absolutely no suggestion to somehow modify Milewski to somehow obtain Applicants' claim 10 because Milewski teaches away from claim 10's feature, as discussed above.

Claims 12-15 depend on and include all limitations of claim 10 and are therefore allowable for at least the same reasons as is claim 10. Accordingly, all assertions in the Office Action regarding claims 12-15 are rendered moot.

Claims 1-9, 20 and 21

Claims 1-9, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Adams in view of Wolff.

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Adams teaches a telephone ringer that can be silenced. The main feature of Adams is that if the telephone ringer is silenced (i.e., turned off) while the telephone is ringing due to an incoming call, then the telephone will automatically un-silence (i.e., turn back on) the ringer after the incoming call no longer is trying to ring the telephone. Adams solves the problem of a user's turning off a ringer to silence a given call and then forgetting to turn the ringer back on.

Claim 1 recites a feature of "means for enabling selective entry of a user message entered in response to the alert while the incoming call is pending and still ringing to the calling party" in which the "user message" is to be "play[ed] to the calling party". The Office Action conceded that "Adams does not specifically teach of playing the selected user message to the calling party." (Office Action, page 4, top.) Applicants respectfully agree. However, the Office Action contended that Adams does teach the "means for enabling selective entry of a user message entered ... while the incoming call is pending and still ringing". Applicants respectfully disagree. Applicants are sincerely and respectfully surprised that Adams is being cited at all in the Office Action.

The Office Action alleges that Adams teaches the "means for enabling selective entry of a user message ..." at Adams, "col. 6, lines 14-37; call continues to ring until after the user sends a user message" (Office Action, page 3, bottom). Applicants respectfully cannot agree with such an interpretation of Adams. The cited portion of Adams at most states merely that the user causes "the mute ringer soft key 18 [to be] depressed" (Adams, col. 6, line 15). That is all. There is no basis in Adams to suggest that turning off the ringer of the telephone (or any other action) is in any way whatsoever an "enter[ing]" of a "user message" that is to be "played" or even sent. In particular, Applicants respectfully submit that no person of ordinary skill in the art at the time of invention would read Adams and conclude that turning off the ringer or any other action is in any sense "selective[ly] ent[ering]" a "user message" that can be played to the calling party. Applicants respectfully submit that the Office Action has fallen into the trap of using impermissible hindsight to look at references through a peculiar and incorrect lens. Accordingly, Applicants respectfully submit

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that Adams does not teach the element of claim 1 that Adams is alleged to teach, and therefore claim 1 is allowable over the cited art.

Claims 2-9 and 20 depend on and include all limitations of claim 1 and are therefore allowable for at least the same reasons as is claim 1. Accordingly, all assertions in the Office Action regarding claims 2-9 and 20 are rendered moot.

(Indeed the assertions are difficult even to discuss because the rejection of the base claim 1 itself is rather difficult to understand. To consider just one example, the Office Action alleges that "Adams in view of Wolff teaches releasing the call after playing the message". But the Office Action admits that there is no playing the message in Adams, and so Applicants respectfully wonder how Adams can teach something "after playing the message" given that there is no "playing the message" in Adams?)

Claim 21 has been amended to correctly depend on claim 10, as originally intended, as can be seen from an antecedent reference in claim 21. Accordingly, claim 21 is allowable over the cited art for at least the same reasons as is claim 10.

Claim 11

Claims 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Wolff. Claim 11 depends on and includes all limitations of claim 10. Accordingly, claim 21 is allowable over the cited art for at least the same reasons as is claim 10.

Claim 16-19

Claims 16-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Weishut in view of Wolff. Claim 16, as amended, recite a step of "detecting, at a recipient telephone, an incoming telephone call, based on the incoming phone call itself" (underlining added). A benefit of the underlined feature is that one embodiment of this method can be implemented in a rather basic telephone without external signaling infrastructure. Weishut, in contrast, does not teach or even suggest the underlined feature. Neither does Wolff. On

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the contrary, Weishut teaches specialized external signaling means, for example, a specialized private branch exchange in which advanced functions can only work between two terminals both connected to the private branch exchange. (See, e.g., Weishut, col. 1, 8-23.) Similarly, Wolff teaches a system that is implemented within a local exchange telephone network in which (a secondary) wireless network is employed to enable advanced functionality (Wolff, Fig. 1, 10). Accordingly, Applicants respectfully submit that claim 16 is allowable over the cited art.

Claims 17-19 depend on and includes all limitations of claim 16. Accordingly, claims 17-19 are allowable over the cited art for at least the same reasons as is claim 16.

New Claims 22-27, and Dependent Claims in General

New claims 22-27 depend on and include all limitations of their respective base claims 1, 10 or 16. Accordingly, the new claims are allowable over the cited art for at least the same reasons as are their respective base claims. More generally, the dependent claims in the present Application are also allowable for the additional limitations that they themselves recite.

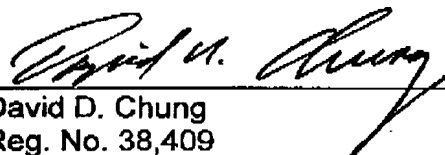
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Conclusion

Therefore, Applicants submit that their invention is not disclosed, taught, or suggested by the references of record, alone or in combination. Therefore, it is submitted that all of the claims are allowable over the art of record and it is respectfully requested that the application be passed to allowance.

Respectfully submitted,

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